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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,695	01/18/2002	Bernard O. Geaghan	56899US003	3808
32692	7590	05/18/2004		
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
			EXAMINER LEFLORE, LAUREL E	
			ART UNIT 2673	PAPER NUMBER 12

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/052,695

Applicant(s)

GEAGHAN ET AL.

Examiner

Laurel E LeFlore

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19, 20 and 22-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19, 20 and 22-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9.11.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 19, 20 and 22-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz et al. 6,498,590 B1 in view of Phares 5,815,141.

In regard to claims 19 and 22, Dietz et al. discloses an invention similar to that which is claimed in claims 19 and 22. See rejection of claim 19 in Paper No. 8 for similarities. Dietz et al. does not disclose a touch sensor switch electrically connected to the touch sensor, a user contact point switch electrically connected to the first user contact point, and a power source, wherein the touch sensor switch and the user contact point switch are further electrically connected to the power source, wherein the touch sensor switch or the first user contact point switch must be closed in order for the system to determine information related to the touch.

In regard to claim 19, Phares discloses a touch system with multiple selectable touch regions. Each of the touch regions is connected to a switch. See figure 2, depicting an embodiment with 2 such regions. Thus, Phares discloses two separate touch regions that are understood to constitute a touch sensor and a user contact point. Each of these regions is electrically connected to a switch. Also see column 3, lines 14-19, disclosing, "at least one of the separate regions can be made sensitive and other

regions made insensitive through the utilization of switching means. Thus, one or more regions can be made insensitive...when activation is desired only in the selected region of the touchscreen.”

In regard to claim 22, see column 4, line 65 to column 5, line 2, in which Phares discloses that a closed switch causes an activation of a touch area, while an open switch makes the touch area inactive.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Dietz et al. by electrically connecting each of the first user contact point and the touch sensor to a switch and making such regions active with the close of respective switches as taught by Phares. One would have been motivated to make such a change based on the teaching of Phares that such utilization of switching means is beneficial “when activation is desired only in the selected region of the touchscreen.” Also, the closing of a switch to cause some activation is common and consistent with conventional use of switches. In regard to the power source connected to the switches, it is inherent that any type of electrical switch requires a power source to be operable.

3. In regard to claims 20, 23-29 and 31-34, see previous rejection of claims 20 23-29 and 31-34 in Paper No. 8.

4. In regard to claim 30, see rejection of claim 19.

5. In regard to claim 35, see previous rejection of claim 23 in Paper No. 8.

6. In regard to claim 36, Dietz et al. discloses an invention similar to that which is disclosed in claim 36. See rejection of claim 19 for similarities. Also see column 3,

lines 14-16, disclosing, "It should be understood that other conductive items can also be used to identify users, e.g. conductive floor mats, wristbands, belts, etc." Thus, Dietz discloses that the user contact point can be placed in varying locations. Dietz et al. does not disclose that the first user contact point and the touch sensor are contained within the same housing.

Phares discloses a system of multiple touch inputs, each mounted in a single touch system housing. See figures 1-3. Also see column 3, lines 8-11, disclosing, "This is achieved...by dividing a conductive cover sheet of a resistive touchscreen into electrically-isolated regions."

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Dietz et al. by mounting the user contact point and touch sensor in a single touch system housing. One would have been motivated to make such a change based on the teaching of Phares that such a placement of touch portions maintains electrically-isolated regions. Also, such a modification making the contact point integral with the touch sensor is obvious (In re Larson, 144 USPQ 347 (CCPA 1965)).

### ***Response to Arguments***

7. Applicant has amended the specification and drawings to overcome the previous objections in Paper No. 8. The objections to the specification and drawings are withdrawn.

8. Applicant's arguments filed 2 April 2004 have been fully considered but they are not persuasive.

9. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10. In page 14 of Paper No. 10, applicant argues features of claim 21 that are not disclosed by Phares. However, they are disclosed by Dietz. The motivation for combining the two references is stated in the rejection of claims 21, 22, 27 and 32 in Paper No. 8.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurel E LeFlore whose telephone number is (703) 305-8627. The examiner can normally be reached on Monday-Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on (703) 305-3885. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LEL  
10 May 2004



JOSEPH MANCUSO  
PRIMARY EXAMINER